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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/575,728	04/13/2006	Hiroshi Matsuoka	1000023-000106	4612
21839	7590	06/06/2008	EXAMINER	
BUCHANAN, INGERSOLL & ROONEY PC			BURNEY, RACHEL L	
POST OFFICE BOX 1404				
ALEXANDRIA, VA 22313-1404			ART UNIT	PAPER NUMBER
			1795	
			NOTIFICATION DATE	DELIVERY MODE
			06/06/2008	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/575,728	MATSUOKA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Rachel L. Burney	1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 13 April 2006.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-18 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-18 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>04/13/2006</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|   | 6) <input type="checkbox"/> Other: _____ .                        |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement (IDS) submitted on 04/13/2006 was filed on the mailing date of the application. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Specification***

2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claims 5, 13, and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 5 recites the limitation "the content of tin" in line 4 of the claim. There is insufficient antecedent basis for this limitation in the claim.

6. Claims 13-18 are rejected as being dependent on previously rejected claim 5.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim1-5 and 9-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over US PGPub 2003/0124448, Shinzo et al.

With respect to claims 1, 9, 14 Shinzo discloses a toner having a resin particle which has an average particle diameter of 0.01 to 1  $\mu\text{m}$  (PP 0118) and has a narrow particle size distribution (PP 0081). The resin particles are prepared in water with an organic solvent, then the organic solvent is removed (PP 0018). Shinzo

does not disclose the D50, D10, and D90, as detailed in the instant application or the amount of organic solvent in the final resin particle. Shinzo does, however, disclose that the resin particles have an average particle diameter within the desired ranges and have a narrow particle size distribution, which is the intention of the instant application, therefore it would be obvious to one of ordinary skill in the art to make a resin particle which has the desired D50, D10, and D90 as the instant application. Shinzo also discloses that the organic solvent is removed after the forming of the resin particle, therefore it would be obvious to one of ordinary skill in the art that the amount of residual organic solvent in the final resin particle would likely be less than 70 ppm.

With respect to claims 2-3, 10-11, and 15-16, Shinzo discloses the resin, dispersion, and toner of claims 1, 9, and 14 as discussed above wherein the resin may be a sulfonic acid group-containing polyester resin (PP 0029).

With respect to claims 4, 12, and 17, Shinzo discloses the resin, dispersion, and toner of claims 1, 9, and 14 as discussed above wherein the resin may also comprise a vinyl resin (PP 0023).

With respect to claims 5, 13, and 18, Shinzo discloses the resin, dispersion, and toner of claims 1, 9, and 14 as discussed above wherein the polyester resin is made from a condensation of dihydric alcohol and dibasic acid (PP 0027), wherein the alcohol may be selected from a large group of compounds comprising many which do not contain a bisphenol A-derived structure (PP 0035). Shinzo does not discuss the inclusion of tin into the resin particles,

therefore it would be obvious to not include tin particles, therefore having a content of less than 5 ppm.

9. Claims 1 and 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over US PGPub 2002/0076639, Uno et al. Uno discloses a toner particle which comprises polyester resin particles having a narrow particle size distribution (PP 0011) and an average particle diameter of 0.01 to 1  $\mu\text{m}$  (PP 0065). The polyester resin has an acid component and an alcohol component (PP 0024), wherein the alcohol may be polyether polyols (PP 0036). The toner particles are prepared by dispersing the resin particles in water (PP 0059).

### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel L. Burney whose telephone number is (571)272-9802. The examiner can normally be reached on Mon-Thurs: 7:30-6:00 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RLB

**/Mark F. Huff/  
Supervisory Patent Examiner, Art Unit 1795**